



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,639	10/27/2003	Michael Cima	TPI-T2200XC2	5317
22913	7590	11/14/2007	EXAMINER	
WORKMAN NYDEGGER 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			BEISNER, WILLIAM H	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			11/14/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/694,639

Applicant(s)

CIMA ET AL.

Examiner

William H. Beisner

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-18 is/are allowed.
- 6) ☒ Claim(s) 1-7, 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/20/2007 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 7 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Berkowitz (US 3,654,047).

With respect to claim 1, the reference of Berkowitz discloses a device that is structurally capable of being used as an assay plate adapted for use with and attachment to a curved animal body part. Specifically, the reference discloses a flexible substrate having a flexible substrate

surface (Figure 4:12); at least one raised pad (Figure 4:10a) extending from the flexible substrate surface and having a substantially planar surface capable of holding a sample thereon and wherein the raised pad has no wall extending beyond and surrounding the planar surface. Also the flexible substrate is sufficiently flexible so as to permit the flexible substrate to conform to a curvature of a curved animal body part.

With respect to claim 2, the planar surface is circular.

With respect to claims 3 and 4, the raised pad includes a sidewall with an 90 degree angle (See Figure 4).

With respect to claim 7, the junction between the top planar surface and sidewall (See Figure 4) is considered a sharp edge.

With respect to claim 19, the device includes a plurality of raised pads (See Figure 4).

With respect to claim 20, the planar surfaces are capable of supporting samples. Note the claimed samples are considered "material worked on" and do not further define the structure of the claimed device (See MPEP 2115).

With respect to claim 21, in the absence of further positively defined structure, the device is considered a transdermal delivery device since it is structurally the same as the device disclosed by the reference of Berkowitz.

4. Claims 1-7 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Mathus et al.(US 6,890,488).

With respect to claim 1, the reference of Mathus et al. discloses a device that is structurally capable of being used as an assay plate adapted for use with and attachment to a

curved animal body part. Specifically, the reference discloses a flexible substrate having a flexible substrate surface (Figure 6:20); at least one raised pad (Figure 6:22) extending from the flexible substrate surface and having a substantially planar surface capable of holding a sample thereon and wherein the raised pad has no wall extending beyond and surrounding the planar surface. Also the flexible substrate is sufficiently flexible so as to permit the flexible substrate to conform to a curvature of a curved animal body part.

With respect to claim 2, the planar surface is square (See Figure 6).

With respect to claims 3 and 4, the raised pad includes a sidewall with an 90 degree angle (See Figure 6).

With respect to claims 5 and 6, the device includes an array of 96 pads (Figure 6:22).

With respect to claim 7, the junction between the top planar surface and sidewall (See Figure 6) is considered a sharp edge.

With respect to claim 19, the device includes a plurality of raised pads (See Figure 6).

With respect to claim 20, the planar surfaces are capable of supporting samples. Note the claimed samples are considered "material worked on" and do not further define the structure of the claimed device (See MPEP 2115).

With respect to claim 21, in the absence of further positively defined structure, the device is considered a transdermal delivery device since it is structurally the same as the device disclosed by the reference of Mathus et al.

***Allowable Subject Matter***

5. Claims 8-18 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 8-15, while the prior art of record discloses a flexible substrate device including at least one raised pad wherein the raised pad does not have a wall extending beyond and surrounding the substantially planar sample receiving surface, the prior art of record fails to teach or fairly suggest using the flexible substrate device by depositing a sample on the raised pad and attaching the substrate onto an animal and performing an experiment using the sample on the pad.

With respect to claims 16-18, the claims are allowable because the prior art of record fails to teach or fairly suggest the use of a lower substrate member having an array of samples supported on raised pads with an overlay of a tissue specimen and an upper member defining a reservoir plate that defines an array of openings that align with the sample receiving surface of the lower substrate.

#### ***Response to Arguments***

7. Applicant's arguments, see page 7, filed 8/20/2007, with respect to the rejection(s) of claim(s) under 35 USC 102 and 103 over the reference of Rudiger et al.(US 4,887,611) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Berkowitz (US 3,654,047) and Mathus et al.(US 6,890,488).

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 571-272-1269. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:15am to 3:45pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys J. Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Beisner/  
Primary Examiner  
Art Unit 1797

WHB